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**FEB 18 2005**

**OFFICE OF PETITIONS**

ON PETITION

In re Application of :  
Eric C. Erike :  
Application No. 10/053,144 :  
Filed: January 18, 2002 :  
Atty Docket No. TRW(VSSIM)3971-1 :  
.....  
.....

This is a decision on the petition, filed February 17, 2005, under 37 CFR 1.313(c)(3) to withdraw the above-identified application from issue after payment of the issue fee. This is also a decision on the request for refund, which is being treated as a petition under 37 CFR 1.181.

The petition under 37 CFR 1.313(c)(3) is **GRANTED**.

The petition under 37 CFR 1.181 is **DISMISSED**.

**DISCUSSION OF THE PETITION UNDER 37 CFR 1.313(c)(3)**

The above-identified application is withdrawn from issue for express abandonment. See 37 CFR 1.313(c)(3).

The application is hereby withdrawn from issue, and the abandonment is hereby recognized.

**DISCUSSION OF THE PETITION UNDER 37 CFR 1.181**

Petitioner requests a refund of the \$1,745 fees paid on February 4, 2005, consisting of the \$1,400 issue fee, the \$300 for the publication fee, and \$45 for the advanced order fee.

MPEP §1308.01 speaks to the situation that, where an application is withdrawn from issue at the initiative of the Office and prosecution is reopened, applicant may request a refund of the issue fee. However, in the instant case, the issue fee is not refundable since the withdrawal from issue is at the request of the applicant. Petitioner's attention is directed to 37 CFR 1.26(a), which reads:

The Director may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent filing for which the fee was paid, including an application, an appeal, or a request for an oral hearing, will not entitle a party to a refund of such fee.

Section 607.02 of the MPEP reads, in part, as follows:

Under 35 U.S.C. 42(d) and 37 CFR 1.26, the Office may refund: (1) a fee paid by mistake (e.g., fee paid when no fee is required); or (2) any fee paid in excess of the amount of fee that is required. See *Ex parte Grady*, 59 USPQ 276, 277 (Comm'r Pat. 1943) (the statutory authorization for the refund of fees under the "by mistake" clause is applicable only to a mistake relating to the fee payment). When an applicant or patentee takes an action "by mistake" (e.g., files an application or maintains a patent in force "by mistake"), the submission of fees required to take that action (e.g., a filing fee submitted with such application or a maintenance fee submitted for such patent) is not a "fee paid by mistake" within the meaning of 35 U.S.C. 42(d). 37 CFR 1.26(a) also provides that a change of purpose after the payment of a fee, as when a party desires to withdraw the filing of a patent application for which the fee was paid, will not entitle the party to a refund of such fee.

As the statute at 35 U.S.C. § 42(d) (as well as the rule) does not permit the refunding of any fee not paid by mistake, in excess thereof, or due to a change in purpose, as in the instant case, the issue fee is not refundable. Further, as this application published on May 30, 2002, the publication fee likewise cannot be refunded.

However, since this application will not issue, and since the advance order fee is not a required fee within the meaning of the statute or the rules, this fee (\$45) is refundable. Accordingly, the payment of the issue fee was owed and required by law at the time of payment thereof and will be refunded in due course.

Telephone inquiries should be directed to the undersigned at (571) 272-3218.

The file will be processed as an abandoned application and referred to Files Repository.

*Frances Hicks*  
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Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy